

REMARKS/ARGUMENTS

Claims 3, 4, 6-10, and 12-20 are pending in this application. By this Amendment, claims 3 and 9 are amended, and claims 15-20 are added. The amendments and added claims introduce no new matter. Claims 5 and 11 are canceled without prejudice to or disclaimer of the subject matter recited in those claims. A Request for Continued Examination ("RCE") is attached. Reconsideration of the application based on the above amendment and the following remarks is respectfully requested.

Applicant appreciates the courtesies extended to Applicant's representative during the November 24, 2008 telephone interview with Examiner Simitoski. Applicant's summary of the substance of the telephone interview is included in the following remarks.

Rejections Under 35 U.S.C. §§102 and 103

The Office Action rejects claims 3, 5, 7 and 8 under 35 U.S.C. §102 as being anticipated by U.S. Patent Appln. Pub. No. 2003/0093667 to Dutta et al. (Dutta); and rejects claims 4, 6, and 9-14 under 35 U.S.C. §103 as having been obvious in view of Dutta and at least one of U.S. Patent Appln. Pub. No. 2002/0131592 to Hinnant, "Strong Enterprise User Authentication: RSA ACE/Server" by RSA Security (RSA), and U.S. Patent No. 7,197,072 to Hsu et al. (Hsu). These rejections are respectfully traversed.

Without conceding the interpretation, or application, of the applied references, and solely to advance prosecution of this application, independent claims 3 and 9 are amended to include features similar to those previously recited in now-canceled claims 5 and 11. The applied references cannot reasonably be considered to teach, or to have suggested, such combinations of features for at least the following reasons.

Dutta is directed to a system for issuing and redeeming tickets in a secure manner (Abstract). Dutta discloses using a Ticket Issuing System (TIS) 12 that may provide, upon request, a ticket to a user device, such as a Personal Trusted Device (PTD) 16. The PTD 16 can communicate with a Ticket Redeeming System (TRS) 14 to redeem a "one-time use" or "multiple use" ticket (see paragraphs [0054], [0056]-[0057], and [0061]-[0062]).

The Office Action alleges that Dutta discloses, for example, the features of claim 3, including sending a request for a certificate; receiving a certificate that contains a second secret encrypted with a public key of the token, the second secret distinct from the first secret; decrypting the second secret with a private key of the token; and generating a one time password based on the second secret based on the redemption request. In particular, the Office Action alleges that "Dutta discloses a method of provisioning a first token (PTD, ¶57) having a first secret (private key, ¶57), comprising sending a request for a certificate (redemption step requests RVO, Fig. 4, step C), receiving a certificate (Take_ticket) that contains a second secret (RVO, ¶63) encrypted with a public key of the token (RVO encrypting with TPD_PuK, Fig. 4, step D), the second secret (RVO) distinct from the first secret (RVO is not the same as the private key of the PTD), decrypting the second secret with a private key of the token (decryption is not explicitly shown, however, it is inherent as the RVO is used by the PTD to generate the RVT/pseudo-random sequence, ¶63 & ¶67, and the RVO is received in encrypted form, Fig. 4, step D & ¶67) and generating a one time password (RVT) based on the second secret (generating the RVT/pseudo-random sequence based on the RVO received, ¶63 & ¶¶75-76)." However, the issuing and redeeming of tickets in Dutta does not reasonably correspond to a method of reprovisioning a token, as would be understood by one of ordinary skill in the art and as used in the context of the pending claims. In Dutta, the relied-upon RVO seed value is specific to a particular ticket and corresponding RVT.

The Office Action also asserts, with respect to now-canceled claim 5, that Dutta allegedly discloses "wherein the second secret (RVO) is a symmetric cryptographic key (value used to generate a password/RVT, ¶63)." In support of this conclusion, the Office Action asserts that a symmetric cryptographic key is merely a "data value." However, one of ordinary skill in the art would understand the term a "symmetric cryptographic key" as more than any "data value". Moreover, the seed value described in paragraph [0063] of Dutta does not reasonably corresponds to a symmetric cryptographic key, as that term would be understood by one of ordinary skill in the art.

Finally, Dutta does not teach replacing the first secret with the second secret, as recited in claim 3 and similarly recited in claim 9.

In reviewing the anticipation standard, the Federal Circuit has stated "[t]o anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375 (Fed. Cir. 2001), *cert. denied*, 122 S. Ct. 1436 (2002) (emphasis added). *See also Sandisk Corp. v. Lexar Media, Inc.*, 91 F. Supp. 2d 1327, 1336 (N.D. Calif. 2000) (stating that "[u]nless all the elements are found in a single piece of prior art in exactly the same situation and united the same way to perform the identical function, there is no anticipation.") and *Aero Industries Inc. v. John Donovan Enterprises-Florida Inc.*, 53 USPQ2d 1547, 1555 (S.D. Ind. 1999) (stating that "[n]ot only must a prior patent or publication contain all of the claimed elements of the patent claim being challenged, but they 'must be arranged as in the patented device' "). This standard for anticipation is also set forth in MPEP §2131, which states that "the identical invention must be shown in as much detail as is contained in the...claim." Further, although the same terminology need not be used, "the elements must be arranged as required by the claim." The rejection of claims 3 and 5 fails to meet the above standard at least because Dutta does not teach each and every element of the claim, as arranged in the claim.

The other references are not applied under 35 U.S.C. §103 in a manner to overcome the shortfalls in the application of Dutta to the subject matter of claims 3 and 9, as amended.

These arguments were discussed with the Examiner during the November 24 telephone interview. No agreement was reached.

Added Claims

Added claims 15-19 are likewise allowable at least for the respective dependence of claims 15-19 on an allowable base claim, as well as for the separately patentable subject matter that each of these claims recites. Added claim 20 is likewise allowable at least for the reasons discussed above with respect to claims 3 and 9.

As discussed during the November 24 telephone interview with the Examiner, Dutta does not teach wherein the certificate is an X.509 certificate, nor would it have been

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apparently obvious to have modified Dutta to include such features based on any objective evidence of record.

CONCLUSION

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 202-481-9900.

The Commissioner is authorized to charge any fees due or credit any overpayment to the deposit account of Townsend and Townsend and Crew LLP, Deposit Account No. 20-1430.

Respectfully submitted,



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Attachments:

Petition for Extension of Time
Request for Continued Examination

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